

IN THE UNITED STATES PATENT & TRADEMARK OFFICE



Applicant: Carter et al. Atty Docket: 16279-14C1

Serial No: 09/939,084 Art Unit: 3671

Filing Date: August 24, 2001 Examiner: Mayo, Tara L.

Title: **"DEVICE AND METHOD FOR TRENCHLESS REPLACEMENT OF  
UNDERGROUND PIPE"**

Box Non Fee Amendment  
Commissioner for Patents  
Washington, D.C. 20231

#9/B  
JUL 27 2002  
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GROUP 3000

AMENDMENT

Sir:

Responsive to the Office Action mailed June 5, 2002, please amend the application as follows:

In the Abstract

Please delete the Replacement Abstract that was submitted with the Preliminary Amendment and insert the Substitute Abstract submitted herewith on a separate page.

In the Claims

Please delete claims 1-48, without prejudice. Applicant will file a continuation application to pursue these claims.

Please amend the claims by replacing like numbered claims with the amended claims set forth below. A marked up version of the amended claims is provided herewith as Attachment A.

1 (Once amended) A device for the trenchless replacement of in-situ pipe, comprising:  
2 a mole;  
3 a length of cable, said being engagable to said mole;  
4 means for pulling said cable in a plurality of cable pulling strokes; and

5 means for releasably holding said cable between said cable pulling strokes, including a  
cable engaging device that grips said cable between said pulling strokes, and releases said cable  
on a pulling stroke.

1 ~~1.~~ (Once amended) A device for the trenchless replacement of in-situ pipe, comprising:  
2 a mole;  
3 a length of cable, said cable being engagable to said mole;  
4 a means for pulling said cable in a series of cyclic strokes that include a pulling stroke  
5 and a recovery stroke;  
6 a first cable engaging member that engages said cable on said pulling stroke and releases  
7 said cable on said recovery stroke; and  
8 a second cable engaging member that engages said cable on said recovery stroke and  
9 releases said cable on said pulling stroke.

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REMARKS

In paragraph 1 of the Office Action it is indicated that the Information Disclosure Statement filed August 24, 2001 fails to comply with certain statutory provisions because all of the references cited therein are not listed on a form PTO-1449. Responsive thereto, Applicant firstly notes that the Examiner has not initialed reference BQ on the PTO-1449 form submitted by Applicant. Applicant therefore specifically requests consideration of reference BQ and that reference BQ be initialed on Applicant's PTO-1449 form.

With regard to the references cited by Applicant that were not listed on a PTO-1449 form, Applicant specifically notes that the two references are Fisk '542 and Lincoln '832. Applicant further notes that these two references are specifically cited in the PTO-892 notice from the Examiner, and they are specifically applied to the claims in the Office Action.

Applicant therefore respectfully submits that a further PTO-1449 from the inventor is not necessary in that these two reference have been considered as to the merits. Applicant therefore respectfully submits that this issue has been resolved.

In paragraph 2 of the Office Action it is indicated that the proposed substitute sheets of drawings have been approved. Applicant appreciates the approval.

In paragraphs 3-5 of the Office Action the Abstract is objected to because it refers to purported merits and speculative applications of the invention, and it includes legal phraseology. Responsive thereto, Applicant is unclear whether this objection is directed to Applicant's "Replacement Abstract" that was submitted with the Preliminary Amendment or the original Abstract that was submitted with the copy of the Specification. Nevertheless, Applicant has provided herewith a Substitute Abstract on a separate page, whereby Applicant submits that this ground of objection has been satisfied.

In paragraphs 6-17 of the Office Action various objections and rejections of claims 1-47 are stated. Responsive thereto, and in light of the indication of allowability related to claims 49-72 (as discussed below), Applicant has elected to delete claims 1-48 without prejudice from this application, and to file a continuation application in which the further prosecution of claims 1-47 will be conducted.

In paragraph 18 of the Office Action it is indicated that claims 51-72 are allowed. Responsive thereto, Applicant appreciates the indication of allowable claims, and in reviewing claim 51, Applicant notes an inadvertent error which Applicant has corrected in this Amendment by adding the word "cable" after the word "said".

In paragraphs 19 and 20 of the Office Action it is indicated claims 15, 49 and 50 are objected to as being dependent upon a rejected base claim but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Responsive thereto, Applicant has deleted claim 15, without prejudice, from this Application in favor of a continuation application to be shortly filed. With regard to claims 49 and 50, Applicant has amended claim 49 to include all of the limitations of independent claim 48 from which it depends, and claim 48 has been deleted without prejudice. Applicant therefore respectfully submits that amended claim 49 and dependent claim 50 (which depends from claim 49) have now been rendered allowable.

In paragraph 21 of the Office Action the Examiner's response to Applicant's remarks in Applicant's Preliminary Amendment are provided. Applicant appreciates the Examiner's close attention to Applicant's remarks and Applicant will address the Examiner's response in the continuation application to be filed shortly.

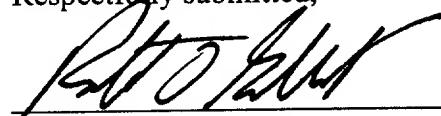
In paragraph 22 of the Office Action further art is made of record. Applicant has reviewed the art and finds that the teachings thereof do not affect the allowability of the remaining claims 49-72 of this Application.

Having responded to all of the paragraphs of the Office Action, and having amended the claims accordingly, Applicant respectfully submits that the claims, as amended, are now in condition for allowance. Applicant therefore respectfully requests that a Notice of Allowance be forthcoming at the Examiner's earliest opportunity. Should the Examiner have any questions or



comments with regard to this Amendment, a telephonic conference at the number set forth below is respectfully requested.

Respectfully submitted,



ROBERT O. GUILLOT

Reg. No. 28,852

Dated: June 21, 2002

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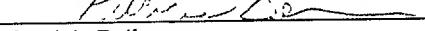
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PATENT TRADEMARK OFFICE

**CERTIFICATE OF MAILING (37 CFR 1.8(a))**

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on June 21, 2002 with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C., 20231.

Date: June 21, 2002



Patricia Beilmann

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SUBSTITUTE ABSTRACT

A trenchless pipe replacement device including a pipe parting mole, a length of cable that is engagable to the mole, a cable pulling device and a cable pulling device engagement ~~means~~ <sup>device</sup> that provides a mounting structure for the cable pulling device. The cable pulling device includes a reciprocating cable engagement mechanism that grips the cable on a pulling stroke and holds the cable on a recovery stroke. The cable pulling device engagement ~~means~~ <sup>device</sup> generally includes a reaction plate and a structure for removably engaging the cable pulling device therewithin. A cable pulling frame may be ~~advantageously~~ used to facilitate the removal of the cable from a relatively small hole that is created at the pulling end of the pipe.

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8/8/02

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ATTACHMENT A - S/N 09/939,084

**MARKED UP VERSION OF THE AMENDED CLAIMS**

1 49. (Once amended) [A device as described in claim 48, wherein said means for releasably  
2 holding said cable consists of] A device for the trenchless replacement of in-situ pipe,  
3 comprising:  
4       a mole;  
5       a length of cable, said being engagable to said mole;  
6       means for pulling said cable in a plurality of cable pulling strokes; and  
7       means for releasably holding said cable between said cable pulling strokes, including a  
8       cable engaging device that grips said cable between said pulling strokes, and releases said cable  
9       on a pulling stroke.

1 51. (Once amended) A device for the trenchless replacement of in-situ pipe, comprising:  
2       a mole;  
3       a length of cable, said cable being engagable to said mole;  
4       a means for pulling said cable in a series of cyclic strokes that include a pulling stroke  
5       and a recovery stroke;  
6       a first cable engaging member that engages said cable on said pulling stroke and releases  
7       said cable on said recovery stroke; and  
8       a second cable engaging member that engages said cable on said recovery stroke and  
9       releases said cable on said pulling stroke.

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Atty Docket: 16279-14C1

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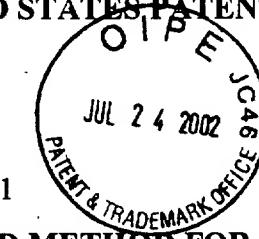
Examiner: Mayo, Tara L.

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Commissioner for Patents

Washington, D.C. 20231

**AMENDMENT TRANSMITTAL**

Transmitted herewith is an amendment for this application.

**STATUS**

Applicant is  
 a small entity.  
 other than a small entity.

**EXTENSION OF TIME**

Applicant petitions for an extension of time under 37 CFR 1.136 for the total number of months checked below:

Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/> one month	\$ 110.00	\$ 55.00
<input type="checkbox"/> two months	\$ 400.00	\$200.00
<input type="checkbox"/> three months	\$ 920.00	\$460.00
<input type="checkbox"/> four months	\$1,440.00	\$710.00

Fee \$ \_\_\_\_\_

If an additional extension of time is required please consider this a petition therefor.

An extension for \_\_\_\_\_ months has already been secured and the fee paid therefor of \$ \_\_\_\_\_ is deducted from the total fee due for the total months of extension now requested.

Extension fee due with this request \$ \_\_\_\_\_

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I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited on June 21, 2002, with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C., 20231.

Date: June 21, 2002

Patricia Beilmann

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Applicant believes that no extension of time is required. However, this conditional petition is hereby made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

### FEE FOR CLAIMS

The fee for claims (37 CFR 1.16(b)-(d)) has been calculated as shown below:

(Col. 1)	(Col. 2)	(Col. 3)	SMALL ENTITY	<i>OR</i>	OTHER THAN A SMALL ENTITY
Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Rate	Addit. Fee	Addit. Fee
Total	Minus *0*	=	x9=	\$	x18= \$
*					
Indep.	Minus *0*	=	x40=	\$	x80= \$
*					
<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEP. CLAIM		+130=	\$	x260= \$	
			TOTAL ADDIT. FEE	<i>OR</i>	TOTAL ADDIT. FEE
			\$		\$

No additional fee for claims required.  
 Total additional fee for claims required \$ \_\_\_\_\_.

### FEE PAYMENT

Attached is a check in the sum of \$ \_\_\_\_\_.  
 Charge Account No. 08-3240 the sum of \$ \_\_\_\_\_.  
 A duplicate of this transmittal is attached.

### FEE DEFICIENCY

In the event that: a) no check to cover the filing fee is enclosed, b) any above-referenced check is inadvertently omitted or lost, or c) any enclosed check is in an amount less than or greater than the required fee, the Commissioner is authorized to charge any required fees, additional fees, or credit any overpayment to Deposit Account 08-3240. A duplicate of this authorization is enclosed for that purpose.

Attached is a postcard for date-stamped return as confirmation of receipt of these materials.

Date: June 21, 2002

ROBERT O. GUILLOT  
Reg. No. 28,852

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